

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Dale E. Gulick
Geoffrey S. Strongin

Serial No.: 09/853,443

Filed: May 11, 2001

For: PROTECTION MECHANISM FOR
BIOMETRIC INPUT DATA

Conf. No. 6306

Group Art Unit: 2132

Examiner: B. Lanier

Atty. Dkt. No.: 2000.039600

Customer No. 23720

REPLY BRIEF

BOX AF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby submits this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's mailed July 20, 2006. No fee is believed due for the filing of this Reply Brief. However, should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed material, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to **Williams, Morgan & Amerson's P.C. Deposit Account 50-0786/2000.039600.**

REMARKS

The Examiner has introduced new grounds of rejection in the Examiner's Answer. Applicants elect to maintain the current appeal. The reasons that Applicants believe the new grounds of rejection are improper are set forth below.

In the Answer, the Examiner repeated the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 set forth in the final rejection in this application. It is believed that the reasons that those rejections are improper are expressly set forth in the Appeal Brief filed in this matter.

On page 6 of the Examiner's Answer, the Examiner introduced new grounds of rejection and alleged that claims 3, 5-6, 13, 18-19, 27, 33-34, 37, 48,-49, 63-64, 67, and 74 are anticipated by Gennaro. These claims depend from independent claims 1, 14, 28, 43, and 58. Applicants therefore respectfully submit that claims 3, 5-6, 13, 18-19, 27, 33-34, 37, 48,-49, 63-64, 67, and 74 are not anticipated by Gennaro for at least the reasons set forth in the Appeal Brief with regard to independent claims 1, 14, 28, 43, and 58.

On page 7 of the Examiner's Answer, the Examiner alleges that the encryption key generated from a user's responses is a nonce because the encryption key is allegedly used a single time. Thus, since the Examiner acknowledges that Gennaro does not explicitly disclose a nonce, Applicants submit that the Examiner is alleging that Gennaro inherently describes a nonce. Applicants note that inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Levy*, 17 U.S.P.Q.2d (BNA) at 1463-64; *Skinner*, at 1789; *In re King*, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. "The mere fact that a certain thing may result

from a given set of circumstances is not sufficient." *Oelrich*, at 326, quoting *Hansgird v. Kemmer*, 40 U.S.P.Q. (BNA) 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; *see also Skinner*, at 1789. "Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987), citing *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981).

Applicants respectfully submit that Gennaro does not inherently disclose a nonce. Gennaro states that the encryption key is formed by concatenating a random combination of provided answers to predetermined questions. See Gennaro, col. 2, ll. 27-31. However, the number of predetermined questions is necessarily limited (*e.g.*, by the knowledge of the user) and therefore the number of possible combinations of answers is also limited. For example, if there are two predetermined questions, then a maximum of four possible combinations of answers exist: the first answer, the second answer, the first answer followed by the second answer, and the second answer followed by the first answer. Consequently, after the fourth challenge, the encryption key formed by the concatenation of the random combination of answers must repeat, contrary to the Examiner's allegation. Applicants therefore submit that the Examiner's asserted proposition (*i.e.*, that the encryption key is used a single time and is therefore a nonce) does not *necessarily* flow from the disclosure and is therefore not inherently disclosed by Gennaro.

In view of the foregoing, it is respectfully submitted that the Examiner erred in rejecting the claims pending in the present application. Accordingly, Applicants respectfully request that

the Board overrule the Examiner's decision and issue instructions that all pending claims be allowed.

Respectfully submitted,

Date: August 25, 2006

//MARK W. SINCELL//

Mark W. Sincell, Ph.D.

Reg. No. 52,226

WILLIAMS, MORGAN & AMERSON

10333 Richmond Avenue, Suite 1100

Houston, Texas 77042

(713) 934-4052

(713) 934-7011 (facsimile)

AGENT FOR APPLICANTS